

### **III. REMARKS**

#### **A. Office Action - Detailed Action**

##### Objection to The Abstract

The abstract was objected to in the Office Action because it exceeded the currently allowable number of words.

In response to this objection, the abstract has been appropriately revised in the Substitute Specification and Abstract included herewith.

##### Claim Rejections under 35 USC § 103(a)

Claims 1-4 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Takase et al. (US 3,965,281).

Claim 1 was rejected as anticipated by Takase et al. Claims 2-4 were rejected as being dependent upon a base claim, but the Office Action indicated claims 2-4 would be allowable in independent form, including the subject matter of the base claim.

In response to this rejection, and as discussed in further detail below, claim 1 has been amended to include a part of the limitations of original claim 2 to distinguish over Takase.

##### Indication of Allowable Subject Matter

Claims 5-10 were indicated as free of the prior art in the Office Action.

##### Double Patenting Rejection

Claim 11 was provisionally rejected under 35 U.S.C. § 101 as claiming the same invention as claim 4 of copending application no. 09/837,920.

In response to this provisional rejection, applicant has cancelled claim 11 in the present application, and is providing a copy of this amendment to the examiner in copending application no. 09/837,920.

## **B. Amendments to the Specification**

Pursuant to the revised amendment practice effective July 30, 2003, both a "clean" and a marked-up copy of the Substitute Specification and Abstract are enclosed. The marked-up copy includes revision markings showing changes from the immediately prior version. In the present case, the revision markings show changes from the original specification and abstract filed in the application.

The Substitute Specification includes several changes to correspond to substitute specifications filed in copending application no. 09/838,045 and application no. 09/837,920 in response to office actions in those applications. The word "course" has been changed to --course-- throughout (as appropriate) the substitute specification; the reference to "45 on page 19, line 5 of the original specification has been changed to --46--; and a few additional changes have been made for grammatical clarification and correction of typographical mistakes.

The Substitute Specification also includes formatting changes, including (1) elimination of all original underlining to distinguish revision mark underlining for indication of addition of text material, (2) addition of paragraph numbers pursuant to currently preferred format guidelines, (3) deletion of duplicate consecutive blank lines, (4) changing of font from Courier to Times New Roman, (5) combining single-sentence "paragraphs" of the original application into a multi-sentence paragraph, and (6) other formatting changes to promote ease of reading and processing by the Examiner. All of the changes to the Substitute Specification are supported by the original application, and such changes do not introduce new matter into the application.

### C. Amendments to the Claims

Pursuant to the revised amendment practice effective July 30, 2003, a complete listing all claims presented in the application is provided above, with current claim status, and the text of all claims currently under examination. Changes to currently amended claims are indicated with revision markings to show the changes as revised from the immediately prior version thereof. The revisions are shown with underlining for added material, strikethrough for deleted material, and double brackets [[ ]] to show deletion of five characters or fewer and deleted material that cannot be easily perceived with a strikethrough.

In response to the 103 rejection, claim 1 has been amended to include a part of the limitations of original claim 2. Original claim 2 included limitations to (i) mixing a surfactant with the surface treatment material and the flakes, and (ii) drying the surface treated flakes. The Office Action indicated claim 2 would be allowable if rewritten in independent form. Applicant has included the surfactant limitation of original claim 2 into amended claim 1, and retained the drying step in claim 2. Amended claim 1 now designates mixing surface treatment material and surfactant with the flakes, and heating the mixture thereof to embed the surface treatment material into the flakes. The invention as now defined in amended claim 1 is not taught or suggested in Takase. Takase generally teaches a method for paving surfaces with asphalt. Takase does teach or suggest use of a surfactant to assist in softening the surface of the flakes and/or to embedding the surface treatment into the flakes as taught in the present invention. Rather, Takase is concerned with simply pressing the mixture thereof onto the surface to be paved. Consequently, Applicant submits that currently amended claim 1, as well as those claims (2-4, and 12-15) depending therefrom, now patentably distinguish over Takase.

For ease of reading, claim 1 has also been amended to (i) remove redundant reference to "asphalt material" when indicating the asphalt material "flakes", (ii) delete the dashes "-" at the beginning of each clause of the claims, and (iii) identify each clause of the claim with clause identification lettering. These changes do not affect the scope of the claim.

Claim 2 has been amended in conformance with the amendments to claim 1, by deleting reference to mixing the surfactant with the surface treatment material and the flakes, and to clarify that the flakes are dried to produce loose product.

Claim 3 has been amended in conformance with the amendments to claims 1 and 2, by changing dependency from claim 2 to claim 1.

Claim 4 has been amended to delete the limitation that the flakes be placed in a substantially flat position for compressing the flakes into a mat. The deleted limitation is not necessary to practicing the invention therein, and the amended claim remains patentably distinguishable over Takase.

For ease of reading, claims 5-9 have been amended to (i) delete the dashes "-" at the beginning of each clause of the claims, and (ii) identify each clause of the claims with clause identification lettering. These changes do not affect the scope of the claims. Claim 7 has also been amended for conforming presentation with amended claim 4.

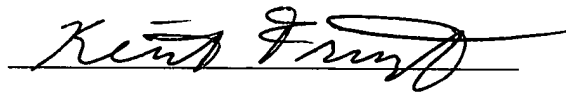
New claims 12-13 and 14-15 are dependent from amended claims 1 and 2, respectively, and therefore allowable over Takase.

New independent claim 16 flows logically from indication of allowable subject matter in the Office Action. Specifically, claim 16 includes softening the surface of the asphalt flakes, embedding the surface treatment material into the softened flakes, and either supplying the surface treated flakes for loose ground cover product or compressing the flakes into a mat. Such

a method is not taught or suggested in Takase. Consequently, Applicant believes that claim 16 and those depending therefrom are allowable over Takase.

In view of the foregoing, Applicant believes claims 1-10 and 12-24 currently pending in the application are in condition for allowance.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Keith Frantz", written over a horizontal line.

Keith Frantz, Reg. No. 37828

Keith Frantz, Reg. No. 37828  
401 West State Street, Suite 200  
Rockford, Illinois 61101  
(815) 987-9820  
(815) 987-9869 [[fax]]  
Serial No. 09/838,034  
Filing Date: 04/18/2001